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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/523,520	11/21/2005	Herfried Lammer	02418-0913	1370
22852	7590	10/02/2007		
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			EXAMINER CHIU, RALEIGH W	
			ART UNIT 3711	PAPER NUMBER
			MAIL DATE 10/02/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/523,520

Applicant(s)

LAMMER ET AL.

Examiner

Raleigh W. Chiu

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date ____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- ☐ Notice of Informal Patent Application
- ☐ Other: ____.

DETAILED ACTION

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 112

2. Claims 1-27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, line 4, it is not clear what is meant by "substantially coupling". That is to say, it is not clear what criterion exists to determine what substantially couples and what does not substantially couple.

Claims 2-27 are rejected because they depend from a rejected claim 1.

Applicant argues that one of ordinary skill in the art would understand the meaning of "without substantially coupling" in light of Applicant's specification, since the specification clearly describes and provides examples of the difference between dampening devices that couple strings and Applicant's dampening device, which is fixed to strings "without coupling the strings" and argues that the phrase "without substantially

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coupling" emphasizes that there is basically no coupling of the strings. See Remarks, page 8. Applicant further argues that the illustrations set forth in Figures 2a-6b of Applicant's specification would allow for one of ordinary skill in the art to understand the meaning of the phrase "without substantially coupling".

However, as "coupling" is defined as the act or process of uniting or connecting things together, Applicant's Figures 2a-6b are all considered to show a dampening device clearly coupling the strings. Therefore, the confusion arises in that it is not clear how one could consistently determine how strings can be connected with each other yet without being substantially coupled with each other.

Further, as shown in Figure 2b, at least between some of the strings, the dampening device contacts each other, but is, according to Applicant, not substantially coupled. As such, it is not clear how much contact can be allowed and not be substantially coupled.

Claim Rejections - 35 USC §§ 102 and 103

3. Claim 1-6, 8, 10, 11, 14-24 and 27 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent Number 4,732,383 (Ferrari et al., hereinafter Ferrari '383) in view of

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U.S. Patent Number 4,911,445 (Ferrari *et al.*, hereinafter Ferrari '445).

Regarding claims 1-6, 8 and 18-24, Figures 1-2 of Ferrari '383 show a foam dampening device that can be woven about the tennis strings such that the strings are not considered to be substantially coupled. Although the ends of the Ferrari '383 dampening device are intended to be tucked under the frame, it would have been obvious to one of ordinary skill in the art to provide a mechanical connector such as a hook at the ends of the device in view of Ferrari '445 in order to better secure the dampening device to the strings.

Regarding claim 10, the Ferrari '383 device is considered to be inherently capable of being positioned on a racquet string bed as recited.

Regarding claim 11, the Ferrari '445 hooks are considered to be capable of being engageable with each other.

Regarding claims 14-17 and 27, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use a foam with the recited physical characteristics, since it has been held to be within the general skill or a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice.

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4. Claims 7, 12, 13, 25 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ferrari '383 and Ferrari '445 as applied above in view of U.S. Patent Numbers 5,096,194 (Yong et al., hereinafter Yong) and 5,398,928 (Rudell et al., hereinafter Rudell).

Regarding claims 7, 12, 13, 25 and 26, in addition to the Ferrari '445 hooks, Yong teaches the concept of using different fasteners such as clips or bolt fasteners to attach a racquet string dampening device to a string bed. See Yong at Figures 7 and 9. As such, it would have been within the level of ordinary skill in the gaming art to use other types of fasteners as a means to secure the Ferrari '383 dampening device to the racquet strings. Moreover, as Rudell teaches that adhesives, hook-and-loop material and clips were art-recognized equivalents in the gaming art, the selection of any of these known fasteners to attach the dampening device to the racquet strings would be within the level of ordinary skill in the art.

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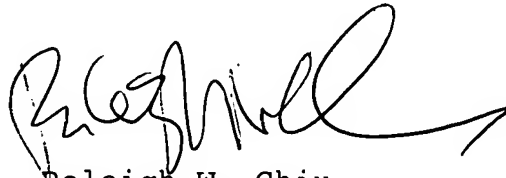
Conclusion

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Raleigh Chiu whose telephone number is (571) 272-4408. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eugene Kim, can be reached on (571) 272-4463.

The fax number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Raleigh W. Chiu
Primary Examiner
Technology Center 3700

RWC:dei:feif

11 September 2007